

### REMARKS

The Examiner indicated that the application contains claims directed to patentably distinct species of the claimed invention, and required the Applicant to elect a single disclosed species for prosecution on the merits. Claims 18 and 19 were rejected under 35 U.S.C. § 112, first paragraph. Claims 2-3, 8-12 and 18-19 were rejected under 35 U.S.C. § 112, second paragraph. Claims 1-3, 8 and 11-12 were rejected under 35 U.S.C. § 102(b). Claims 1-13 and 18-19 were rejected under 35 U.S.C. § 103(a).

Reconsideration of the outstanding rejections is requested in light of the forgoing amendments and the following comments. Claims 1, 3-12 and 20-22 are pending in the application. Claims 2, 13, 18 and 19 are canceled. Claims 14-17 are withdrawn. No new matter has been added.

#### *Response to Election of Species Requirement*

In the Election of Species Requirement included in the Office Action mailed September 28, 2004, the Examiner requested that the Applicant elect among of species from the following groups of claims:

- Group I:       the species shown in Figs. 1-4 and 6; and
- Group II:       the species shown in Fig. 5.

Applicant hereby elects, without traverse, Group I, which includes at least pending claims 1 and 3-12, and new claims 20-22 for prosecution on the merits.

#### *Claim Rejections under 35 U.S.C. § 112*

Claims 18 and 19 were rejected under 35 U.S.C. § 112, second paragraph, as failing to comply with the enablement requirement. Specifically, the Examiner states that it is not clear from the specification what the applicant considers to be a naturally weighted material or a naturally buoyant material. Claims 18 and 19 have been canceled, rendering the Examiner's rejection moot.

Claims 2-3, 8-12 and 18-19 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the applicant regards as the invention. Claims 2, 18 and 19 have been canceled, rendering the Examiner's rejection of these claims moot. Claims 3, and 8-12 have been amended to particularly point out and distinctly claim the subject matter of the invention. In particular, certain prior recitations, such as "or an equivalent" or "relatively," have been deleted to clarify the subject matter being claimed. Applicant respectfully requests that the rejection under 35 U.S.C. § 112, second paragraph, be withdrawn.

***Claim Rejections under 35 U.S.C. § 102(b)***

**Claims 1-3, 8 and 11-12** were rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent Number 5,096,453 to Van Meter ("Van Meter").

Independent claim 1 has been amended to recite "a fabric portion reconfigurable between a closed position in which it is collapsible and an open position in which it is substantially planar . . . at least one buoyancy member positioned at a selected location on the fabric portion; and at least one weight positioned at a selected location on the fabric portion, the at least one buoyancy member and the at least one weight positioned such that the fabric portion extends into the open position when submerged in water."

Unlike independent claim 1, which recites "a fabric portion reconfigurable between a closed position in which it is collapsible and an open position in which it is substantially planar," Van Meter is entirely silent. Van Meter merely discloses a stuffed toy with detachable appendages. Van Meter also fails to disclose or suggest "at least one buoyancy member" as recited in claim 1.

Accordingly, at least for these reasons, claim 1 is patentable over Van Meter. Based at least on their dependence upon claim 1, claims 3, 8, and 11-12 are also patentable over Van Meter.

**Claims 1-13 and 18-19** were rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent Number 6,332,822 to Greenberg et al. ("Greenberg").

Unlike independent claim 1, which recites "a fabric portion reconfigurable between a closed position in which it is collapsible and an open position in which it is substantially planar," Greenberg is entirely silent. Greenberg merely discloses a diving stick having a cylindrical body with two chambers, one to hold a weight the other to hold air and water.

At least for this reason, claim 1 is patentable over Greenberg. Based at least on their dependence upon claim 1, claims 3-12 are also patentable over Greenberg (claims 2, 13, 18 and 19 being canceled).

***Claim Rejections under 35 U.S.C. § 103***

**Claims 1-13 and 18-19** were rejected under 35 U.S.C. § 103(a) as being unpatentable over Greenberg in view of U.S. Patent Number 3,332,166 to Alexander ("Alexander").

Unlike the present invention as recited in independent claim 1, Alexander merely discloses a toy hoop with a movable weight member. Alexander fails to disclose or suggest "a fabric portion reconfigurable between a closed position in which it is collapsible and an open position in which it is substantially planar" as recited by claim 1. Alexander also fails disclose or suggest "at least one buoyancy member" and "at least one weight" each "positioned such that the fabric portion extends into the open position when submerged in water" as claimed in claim 1. Greenberg merely discloses a diving stick as described above and adds nothing to Alexander. Thus, neither Alexander nor Greenberg, alone or in proper combination, teach or suggest the invention as recited in claim 1.

At least for these reasons, claim 1 is patentable over Alexander and Greenberg. Based at least on their dependence upon claim 1, claims 3-12 are also patentable over Alexander and Greenberg (claims 2, 13, 18 and 19 being canceled).

**Claims 1-2, 8 and 11-12** stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Alexander in view of U.S. Patent Number 5,538,454 to Kessler (“Kessler”).

Kessler discloses decoration of children’s playthings including an exercise and entertainment hoop. The decoration includes attaching a fabric or other material to the surface of the plaything being decorated.

As discussed above, Kessler fails to disclose or suggest several recitations of independent claim 1. Unlike independent claim 1, which recites “a fabric portion reconfigurable between a closed position in which it is collapsible and an open position in which it is substantially planar,” Kessler is entirely silent. Kessler also fails to disclose or suggest an “opening formed in the fabric portion” as recited by claim 1. Thus, Kessler adds nothing to Alexander. Neither Kessler nor Alexander, alone or in proper combination, disclose or suggest an invention as recited by claim 1.

At least for these reasons, claim 1 is patentable over Alexander and Kessler. Based at least on their dependence upon claim 1, claims 8, 11 and 12 are also patentable over Alexander and Kessler (claim 2 being canceled).

#### ***New Claims 20-22***

New claim 20 is dependent from claim 1. As discussed above, claim 1 is patentable over the cited references. Based at least on its dependence from claim 1, new claim 20 is also patentable over the cited references.

New independent claim 21 recites “a substantially planar fabric portion including an interior portion defining an opening and an exterior portion extending outwardly from the opening, the exterior portion including an unconstrained peripheral edge of the fabric portion.” The cited references fail to disclose or suggest a fabric portion as recited in new claim 21.

New independent claim 22 recites “a fabric portion including an interior portion defining an opening and an exterior portion extending outwardly from the opening, the

exterior portion including an unconstrained peripheral edge of the fabric portion.” The cited references fail to disclose or suggest a fabric portion as recited in new claim 22.

The Applicant respectfully submits that at least for these reasons, new claims 20-22 are patentable over the cited references.

### CONCLUSION

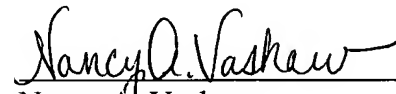
All of the stated grounds for rejection have been properly traversed or rendered moot. Applicant therefore respectfully requests that the Examiner reconsider and withdraw all presently outstanding rejections. Applicant also requests allowance of the new claims 20-22. Applicant believes that a full and complete response has been made to the outstanding Office Action and, as such, the present application is in condition for allowance. If the Examiner has further questions in connection with this application or believes that personal communication would be helpful in the prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided below.

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